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| 20210 | 7590 | 09/21/2004 | EXAMINER | |
| DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151 | | | SHIMIZU, MATSUICHIRO | |
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| | | | 2635 | |

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,572

Applicant(s)

EMMEI, TOSHIHARU

Examiner

Matsuichiro Shimizu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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Response to Second Preliminary Amendment

The examiner acknowledges and approves Substitute Specification filed on 4/22/2002 in view of following;

- (1) there is no new subject matter,
- (2) marked-up copy of original specification, and
- (3) clean form substitute specification.

Therefore, Substitute Specification will be entered by LIE.

Response to Preliminary Amendment

The examiner acknowledges canceled claims 1-5 and new claims 6-9.

Statutory Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The claimed elements of US-6,388,558 (claims 1-3) perform the function specified in the applicant's pending claims 7-9. The sole difference between the pending claims and the patented claims is the change of the term "means for" (patent) to "mechanism for" (application). In reviewing 112 6th paragraph it is the examiner's position that mechanism, like the term means is generic. It is therefor the position of the examiner that the term "mechanism for" invokes the identical scope as the term "mean for" in this instance. The claimed elements of the application (claims 7-9) are identical to the elements in claims 1-3 of US

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pat. '558, and therefore, a statutory type (35 U.S.C. 101) double patenting rejection is applicable. A side by side analysis follows:

Claims 7-9 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3 of prior U.S. Patent No. 6,388,558. This is a double patenting rejection.

Regarding claims 7-9, US-6,388,558 claims the key system (col. 16, line 11) for a lock mechanism activated by at least one of an ID card and a mechanical key (col. 16, line , the key system (col. 16, line 11) comprising:

ID signal receiving mechanisms (col. 16, line 13, means and mechanism provide identical element) for receiving ID output signals transmitted from the ID card;

ID extracting mechanism (col. 16, line 15, means is equivalent to mechanism within the claimed scope) for extracting ID card data from ID output signals received by the ID signal receiving mechanism;

ID storage mechanism (col. 16, line 19, means is equivalent to mechanism within the claimed scope) for maintaining stored ID data;

coincidence determination mechanism (col. 16, line 20, means and mechanism provide identical element) for ascertaining whether or not there is stored ID data coinciding with the ID card data extracted by the ID extracting mechanism;

a mechanical key switch (col. 16, line 28, means and mechanism provide identical element) having a port for receiving the mechanical key, the mechanical key switch controlled by an operation enabling mechanism permitting operation of the key switch;

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the key system further comprises a first mode and a second mode (col. 16, lines 33–34), in the first mode (col. 16, line 34) the mechanical key is received in the mechanical key switch port and the ID signal receiving mechanism received ID output signals transmitted from the ID card and where the coincidence determination mechanism (col. 16, line 37, means and mechanism provide identical element) ascertains coincidence of the stored ID data and the extracted ID card data the operation enabling mechanism (col. 16, line 40, means and mechanism provide identical element) is actuated to enable operation of the mechanical key switch; and

in the second mode (col. 16, line 43) the operation enabling mechanism is actuated solely by the ID card wherein the ID signal receiving mechanism receives ID output signals transmitted from the ID card and where the coincidence determination mechanism ascertains coincidence of the stored ID data and the extracted ID card data, the operation enabling mechanism is actuated to enable operation of the mechanical key switch without the mechanical key (claim 7);

a master ID card (col. 16, line 53) wherein the key system is selected to be operated in one the first and second mode by setting the mechanical key switch to an operation mode selection position and the ID signal receiving mechanisms receives the master ID card data transmitted from the master ID card and where the coincidence determination mechanism ascertains coincidence of the master ID card and the stored master ID card one of the first and second mode is selected (claim 8); and

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the mechanical key switch (col. 16, line 63) receives the mechanical key to enable setting of the mechanical key switch to the operation mode selection position (claim 9).

Non-Statutory Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,388,558. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

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Regarding claim 6, US-558 claims a key system for lock mechanism, the key system comprising:

an ID card for storing ID data (col. 16, lines 13-17, extracting ID data from an ID card is obviously an ID card for storing ID data);

ID storage mechanism, other than the ID card, for maintaining stored ID data (col. 16, line 19, obviously storage out-side of the ID card within the scope of claim 1);

coincidence determination mechanism for ascertaining whether or not the ID data stored in the ID card and the ID data stored in the ID storage mechanisms coincide with each other (col. 16, lines 20-22, obvious to limitation of claim 1) ;

a mechanical key (col. 16, lines 29-31, obvious to limitation of claim 1);

a mechanical key switch for being enabled by mechanism of the mechanical key (col. 16, lines 29-31, obvious to limitation of claim 1) ;

operation enabling mechanism for enabling the mechanical key switch without the mechanical key (col. 16, lines 49-51, obvious to limitation of claim 1)

and

control mechanism for controlling the equipment operation, the control mechanism enabling the equipment operation (1) when the mechanical key switch is enabled by the mechanical key as well as the coincidence determination mechanism ascertains coincidence of the ID data stored in the ID card and the stored ID data maintained in the ID storage mechanisms (col. 16, lines 33-42, the first mode activation of equipment operation), and (2) when the operation enabling mechanisms is actuated to enable the equipment operation solely by the ID card where the coincidence determination mechanism ascertains

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coincidence of the ID data stored in the ID card and the stored ID card maintained in the ID storage mechanism (col. 16, lines 49–51, second mode activation solely as a result of the ID card matching in the claim 1). That is, control mechanism (claim1) in instant application corresponds to the key system comprising the first mode and second mode (claim 1) in US–558.

Claim 1 of US–558 additionally claims other limitations as well as more narrowly defining the control mechanism. Therefore, claim 1 of US–558 is narrower in scope than pending claim 6 of patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are generally broader than the claims in the patent. Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214 USPQ 761, 766 and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying “meat” is obvious double patenting of narrow patent claim specifying “pork”).

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kokubu (5,801,614) in view of Cremers et al. (5,742,236).

Regarding claim 6, Kokubu discloses a key system which uses, as a key, an ID card (2, Figs. 20-21, column 14, lines 50-61) for outputting ID output signals including ID data to the outside, comprising: ID signal receiving means (column 5, lines 27-67 and column 6, lines 1-9, ID code and preset register); ID extracting means (column 5, lines 27-67 and column 6, lines 1-9, ID code and preset register); ID storage means (column 5, lines 27-67 and column 6, lines 1-9, ID code and preset register); coincidence determination means (column 5, lines 27-67 and column 6, lines 1-9, ID code and preset register); operation enabling means (column 5, lines 27-67 and column 6, lines 1-9, ID code and preset register); said ID card, a driver's license (column 5, lines 8-9); and preset register code in the microprocessor (column 6, lines 6-9, storage of preset code); and the control mechanism enabling the equipment operation and (2) when the operation enabling mechanisms is actuated to enable the equipment operation solely by the ID card (col. 6, lines 42-54, ID card enables actuation of engine start) where the coincidence determination mechanism ascertains coincidence of the ID data stored in the ID card and the stored ID card maintained in the ID storage mechanism. But Kobuku does not teach (1) when the mechanical key switch is enabled by the mechanical key as well as the coincidence determination mechanism ascertains coincidence of the ID data stored in the ID card and the stored ID data maintained in the ID storage mechanisms.

However, Cremers discloses, in the art of vehicle security system, (1) when the mechanical key switch is enabled by the mechanical key as well as the

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coincidence determination mechanism (col. 5, line 58 to col. 6, line 11, action of serrated profile key 14 and matching of key code 34 actuates the enablement of engine start) ascertains coincidence of the ID data stored in the ID card and the stored ID data maintained in the ID storage mechanisms to provide higher security. Therefore, it would have been obvious to a person skilled in the art at the time the invention was made to include (1) when the mechanical key switch is enabled by the mechanical key as well as the coincidence determination mechanism ascertains coincidence of the ID data stored in the ID card and the stored ID data maintained in the ID storage mechanisms in the device of Kokubu as evidenced by the device of Cremers because Kokubu suggests the control mechanism enabling the equipment operation associated with (2) when the operation enabling mechanisms is actuated to enable the equipment operation solely by the ID card where the coincidence determination mechanism ascertains coincidence of the ID data stored in the ID card and the stored ID card maintained in the ID storage mechanism and Cremers teaches (1) when the mechanical key switch is enabled by the mechanical key as well as the coincidence determination mechanism ascertains coincidence of the ID data stored in the ID card and the stored ID data maintained in the ID storage mechanisms to increase security level.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matsuichiro Shimizu whose telephone number is (703) 306-5841. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Micheal Horabik, can be reached on (703-305-4704). The fax phone number for the organization where this application or proceeding is assigned is (703-305-3988).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-8576).

Matsuichiro Shimizu

September 17, 2004



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